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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,320	12/29/2000	Raul S. San Martin	10360-077001 / 12299RO	9159

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EXAMINER
FAROOQ, MOHAMMAD O

ART UNIT	PAPER NUMBER
2182	

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/751,320	SAN MARTIN ET AL.
	Examiner	Art Unit	
	Mohammad O. Farooq	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 January 2005*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,8-12,15-19 and 22-25* is/are rejected.

7)☒ Claim(s) *6,7,13,14,20 and 21* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 December 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

1.   Claims 1-4, 8-11, 15-18, and 22-25 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Kirouac et al. U.S. Pat. No. 5,155,847 in view of Jones, U.S. Pat. No.

6,526,574 B1.

2.   As to claim 1, Kirouac et al. teach method implemented in a computer program

application for updating software on a programmable device, the method comprising the

steps of:

causing a server to establish two way communication between the server (i.e.

central computer) and the programmable device (i.e. remote computer; via

communication links; col.1, lines 67-68);

updating the software on the programmable device in accordance with an

updating process by transmitting at least one file from the server to the programmable

device (inherent; col. 2, lines 1-12); and

testing the operation of at least a portion of the updated software on the programmable device (col. 2, lines 13-26).

Kirouac et al. do not teach restart. Jones teaches restart (abstract). However, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kirouac et al. and Jones because that would convert old file into new file (col. 2, lines 1-34).

3.   As to claims 2 and 3, Kirouac et al. do not teach method backing up at least a portion of the pre-existing software on the programmable device; based upon the testing, restoring the backed portion of the software on the programmable device; and backing up occurs on the programmable device.

Jones teaches backing up at least a portion of the pre-existing software on the programmable device; based upon the testing, restoring the backed portion of the software on the programmable device; and backing up occurs on the programmable device (abstract). However, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Kirouac et al. and Jones because that would implement the update according to the end user (abstract).

4.   As to claim 4, Kirouac et al. teach method the backing up occurs at the server (col. 3, line 60 – col. 4, line 61).

5.   As to claim 8, Kirouac et al. teach method send a signal to a user based upon the

testing outcome (i.e. implement checksums to verify the correct transmission; col. 2,

lines 49-62).

6.   As to claim 9, Kirouac et al. teach system for updating software on a

programmable device comprising:

        a server (central computer; see fig. 1), and

        a programmable device (remote computer) able to be in a two way

communication with the server (col. 1, lines 67-68);

        the server comprising computer software comprising instructions to cause the

server to establish two way communication with the programmable device (col. 1, lines

56-68);

        update software on the programmable device in accordance with an update

process (col. 2, lines 1-12); and

        test the operation of at least a portion of the updated software on the

programmable device (col. 2, lines 13-15).

        Kirouac et al. do not teach restart. Jones teaches restart (abstract). However, it

would have been obvious to one of ordinary skill in the art at the time of the invention to

combine the teachings of Kirouac et al. and Jones because that would convert old file

into new file (col. 2, lines 1-34).

7.   As to claim 15, Kirouac et al. teach computer program product, tangibly stored on

a computer-readable medium, for updating software on a programmable device,

comprising instructions operable to cause a programmable processor to:

        establish communication with the programmable device over a two way

communications medium (col. 1, lines 67-68);

        backup at least a portion of the software on the programmable device;

        update software on the programmable device in accordance with an update

process (col. 1, lines 54-68; col. 2, lines 1-12); and

        test the operation of at least a portion of the updated software on the

programmable device (col. 2, lines 13-15).

        Kirouac et al. do not teach backup at least a portion of the software on the

programmable device.   Jones teaches backup at least a portion of the software on the

programmable device (abstract). However, it would have been obvious to one of

ordinary skill in the art at the time of invention to combine the teachings of Kirouac et al.

and Jones because that would implement the update according to the end user

(abstract).

8.   As to claims 23 and 24, Kirouac et al. teach method the programmable device

restarts running the updated software if the programmable device passes the testing

(col. 2, lines 1-62; col. 3, line 60 – col. 4, line 61).

9.   As to claim 25, Kirouac et al. teach method the programmable device restarts

running the updated software if the programmable device passes the testing (col. 2,

lines 1-62; col. 3, line 60 – col. 4, line 61).

10.   Claims 10 and 11 are system claims of method claims 2 and 4, Kirouac et al. and

Jones in combination teach method as set forth in claims 2 and 4. Therefore, Kirouac et

al. and Jones in combination also teach system as set forth in claims 10 and 11.

11.   Claims 16-18 are product claims of method claims 2-4. Kirouac et al. and Jones

in combination teach method as set forth in claims 2-4. Therefore, Kirouac et al. and

Jones in combination also teach product as set forth in claims 16-18.

12.   Claim 22 is product claim of method claim 8. Kirouac et al. and Jones in

combination teach method as set forth in claim 8. Therefore, Kirouac et al. and Jones in

combination also teach product as set forth in claim 22.

13.   Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kirouac et al. U.S. Pat. No. 5,155,847 in view of DeKoning et al. U.S. Pat. No.

6,480,955 B1.

14.   As to claim 5, Kirouac et al. do not teach the communications is over the Internet.

DeKoning et al. teach the communications is over the Internet (col. 8, lines 10-

18). However, it would have been obvious to one of ordinary skill in the art at the time

of invention to combine the teachings of Krouac et al. and DeKoning et al. because that

would provide completion progress messages to be communicated until the

configuration change request is completely processed (col. 2, lines 36-54).

15.   Claims 12 is system claim of method claim 5. Kirouac et al. and DeKoning et al.

in combination teach method as set forth in claim 5. Therefore, Kirouac et al. DeKoning

et al. in combination teach system as set forth in claim 12.

16.   Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirouac

et al. U.S. Pat. No. 5,155,847 in view of Jones, U.S. Pat. No. 6,526,574 B1 further in

view of DeKoning et al. U.S. Pat. No. 6,480,955 B1.

17.   As to claim 19, neither Kirouac et al. nor Jones teach the communications is over

the Internet. DeKoning et al. teach the communications is over the Internet (col. 8, lines

10-18). However, it would have been obvious to one of ordinary skill in the art at the

time of invention to modify the teachings of Krouac et al. and Jones with DeKoning et al.

because that would provide completion progress messages to be communicated until

the configuration change request is completely processed (col. 2, lines 36-54).

Allowable Subject Matter

18.   Claims 6,7, 13, 14, 20 and 21 are objected to as being dependent upon a

rejected base claim, but would be allowable if rewritten in independent form including all

of the limitations of the base claim and any intervening claims.

Response to Arguments

19.   Applicant's arguments filed January 24, 2005 have been fully considered but they

are not persuasive.

20.   The examiner agrees with the applicant Jones reference teach user intervention

required for the upgrade, and the upgrade process is not automatic (i.e. requires user

intervention). However, the applicant has failed to distinctly point out in the any of the

independent claims the upgrade process is without user intervention. Since claims are

to be given broadest reasonable interpretation, "...causing a server..." could be

interpreted as by the way of a user intervention. Therefore, the examiner retains the

rejection of previously rejected claims.

21.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

22.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mohammad O. Farooq whose telephone number is

(571) 272-4144. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey A. Gaffin can be reached on (571) 272-4146. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).
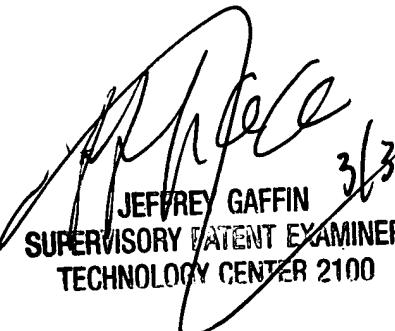
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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Mohammad O. Farooq
March 29, 2005